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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,144	01/25/2001	Spencer A. Rathus	660-018	8423

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Ward & Olivo
382 Springfield Avenue
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EXAMINER

LE, THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,144

Applicant(s)

RATHUS ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-267 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 168-267 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/25/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The preliminary amendment filed on 1/25/2001 has been entered. Claims 168-267 are presented for examination.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 168, 262, and 265 are rejected under 35 U.S.C. 102(e) as being anticipated by Wellner (Wellner – 5,640,193).

Wellner discloses a system that allows multimedia service access by reading marks on an object. Specifically, Wellner discloses a scanner 11 for reading bar codes [see summary of the invention, col. 2]. The scanned data is decoded into a request and communicated to server 13 for handing the decoded request. In col. 4, lines 30-35,

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Wellner discloses that the bar codes work similar to URL identifiers. Figure 2 of Wellner shows the use of a bar code reader, a catalog 10, a communication network for retrieving encoded information, and a display system for displaying information to a reader.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 169 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (Wellner – 5,640,193) in view of Hidary et al. (hereinafter Hidary – 5,774,664).

Regarding claim 169, see discussions above regarding claim 168. The claim differs in calling for the use of a data-link associating with the claimed code. It would have been obvious to associate the code in a data-link. The use of a data-link for feeding encoded information is notoriously known and old that an ordinary skilled artisan would have been used the technique as an alternative input source. Reference to Hidary is cited as evidence showing the conventionality of the claimed limitation. Specifically, Hidary discloses an enhanced video programming system and method for incorporating and displaying retrieved integrated internet information segments. The system includes a client software 106 retrieves URLs from the video program embodiment of FIG. 1) or directly from the Internet connection (embodiments of FIGS. 2 and 4), interprets these URLs and directs the JAVA enabled browser 98 to retrieve the particular relevant Web pages 102, and synchronizes the retrieved Web pages to the video content for display on the user's computer 16, as shown in FIGS. 3 and 4 and explained in more detail in the specification.

Claim 170-261, 263-264, 266 and 267, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (Wellner – 5,640,193) in view of Hidary et al. (hereinafter Hidary – 5,774,664) and in view of the general teachings of the prior art of

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record (Shachar – 6,012,102; Veeneman et al. – 5,774,874; Montanari et al. – 5,478,990; Dudle et al. – 5,570,291).

Regarding claims 170-261, 263-264, 266 and 267, see the discussions above. The claims differ in calling for the use of an alternative form of a code such as a watermark, an invisible barcode, a magnetic code, a printer character, a invisible icon, etc. The claim also recites the use of various different type of networks, the use of a menu, listings, the method of payments and shipments. It would have been obvious to incorporate all these limitations in the system as taught by Wellner, as has been modified above by Hidary. The general teachings of the prior art include the use of a watermark, a magnetic code, a printed character, an icon, etc., as a data input source. Without any specific and unexpected result, replacing one source of input with another known source of input would have been design consideration; and would have not been considered novel. For similar reasons, it would have been obvious to replace one type of network with another since the use of various different networks are known to an ordinary skilled artisan in the art. Choosing one type of network over another would merely depend on the type of applications, the services being offered. Finally, it would have been obvious to include the claimed steps of providing payment, shipping, and returning information in the combined systems. The methods of providing payment/shipping/returning information are notorious known and old and have been made commercially available. Various references in the cited prior art of record are herein discussed as evidence showing the conventionality of some of the claimed limitations.

Shachar discloses a system using machine-readable printed symbols created from encoded data resource specifiers to establish connection to data resource on data communications network. Specifically, Shachar provides a technique for encoded printed presentation and manipulation of addresses of data and/or information resources located on an Internet, e.g., the Internet. The printed form of the addresses can be, for example, a barcode, or other digitally encoded representation which can be scanned electronically. A terminal device for Internet access (e.g., a personal computer or smartphone adapted to data services) is provided with a scanner for reading the encoded address. Application software running on the terminal device would then use the scanned address to establish a network connection, or simply to store the scanned address for later access. Using this technique, it is possible to scan a bar coded representation of a WWW site address (printed, for example, on a business card, in a newspaper ad, or the like) and to automatically and immediately generate an Internet connection to the WWW site and to display/activate a web page.

Veeneman discloses a multi-merchant gift registry system. The system includes a bar code scanner 40 could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes bar codes for the items. The registrant would communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not limited to a physical paper catalog, but also encompasses things such as CD-ROMs, and other data storage devices. In this embodiment, it would be required that there be a unique bar code for each catalog to identify the supplier of the

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particular item. This identifying code could be on the front cover, the back cover, or somewhere within the catalog.

Montanari et al. disclose a method for tracking the production history of food product. FIG. 1 shows a tag that is encoded with a Tracking Number. According to Montanari, the tag is used to convey 1) an Animal Tracking Number (A-TN) which is the tracking number applied to a live animal; 2) an Offal Tracking Number (O-TN) which is attached to offal products; 3) a Production Tracking Number (P-TN) that is attached to a quarter of meat and that identifies fabricated primals and sub-primals derived from the animal of origin; and 4) a Retail Tracking Number (R-TN) that is presented on a primal or sub-primal cut for retail identification. As ownership and possession of an animal is transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or computer readable form, such as a bar-code or magnetic strip, and vital information, such as prior owners, genetic history, weight, feeding history, microbacterial profiles, diseases, medications, etc., may be added to the database record via such tag at various times in the growth of the animal, as well as in the fabrication process.

Dudle et al. disclose a custom product estimating and order processing system. According to the system includes the method for generating estimates and orders for the manufacture of custom items such as business forms is provided which stores estimate data at a central location, e.g., a corporate office, for access by sales

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representatives at remote sales sites. A sales representative creates an item specification for a form to be manufactured and electronically transmits it to the corporate office for estimate data. Data relating to the cost and list price to produce the form based on the item specification is transmitted to the sales representative. The sales representative determines a sell price from the pricing data, and generates a production order using the item specification and the estimate data, among other data. The production order is transmitted to a manufacturing plant for job execution. The system manages a centralized repository of item specification, estimate and customer contract data, among other types of data, for analysis and reporting which can be accessed by computers at different manufacturing plants and sales sites.

Remarks

Due to a large number of claims involving a series of patent applications deriving the benefit from U.S. Patent Application No. 09/365,961 and 08/628,246, the examiner has made an attempt to provide cite all references which are representative of the general teachings of the prior art that are appeared to be pertinent to the underlying concepts of the applicants' invention. In this instant application, since the set of claims is large and is somewhat broad with reference to the teachings of the prior art, the examiner respectfully recommends applicant to review the set of references cited in this Office Action; and to amend the claims accordingly such that they are clearly defined over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**Le, Thien M.
Primary Examiner
Art Unit 2876
May 29, 2002**